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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,996	03/13/2001	Hiroyuki Sekihata	1095.1170/JDH	9371

21171 7590 03/05/2004

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,996

Applicant(s)

SEKIHATA ET AL

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 6 are indeterminate because the preamble recites an apparatus, but the dependent claims recites only a method step.

Claims 4 and 5 are unclear due to the use of "collation" and "collated".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 8, 9, 11 and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by the epixtech website.

Epixtech shows book stock information management means; bibliographic information management means; and loan information management means.

As to claim 2, epixtech shows that the loan information management means enables a library to modify the loan information of another library since it checks books in and out on interlibrary loan and enters their status.

As to claim 3, epixtech shows ordering information management means comprising the acquisitions module and order means comprising the electronic ordering system.

As to claim 8, epixtech shows statistical information generating means.

As to claim 9, epixtech shows request receiving means, searching means, and result transmitting means.

As to claim 11, epixtech shows all steps of the claim, as discussed regarding claim 1.

As to claim 12, epixtech shows software causing a computer to perform all recited functions, as discussed regarding claim 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Green et al (4,153,931).

Green et al show book stock information management means; bibliographic information management means; and loan information management means.

As to claim 8, Green et al show statistical information generating means.

As to claim 11, Green et al show all steps of the claim, as discussed regarding claim 1.

As to claim 12, Green et al show software causing a computer to perform all recited functions, as discussed regarding claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al in view of "MIT Report to the President 1994-95"

Green et al show all elements of the claim except order information management means and ordering means. MIT Report shows these elements. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Green et al by adding the order information management and order placing means in order to streamline the acquisition process.

As to claim 4, it is noted that the Green et al in view of MIT Report shows means capable of receiving collation information comprising the central processing unit which is

networked to the branches (see, e.g. Fig. 1 of Green et al); and means capable of transmitting the collation information to the vendor (see the networked link between the central computer of MIT Report and the vendor).

As to claim 6, the ordering means is capable of placing an order at a price reduced in accordance with an order quantity.

Alternatively, Green in view of MIT Report shows all elements of claim 6 except placing an order at a reduced price based on quantity. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the apparatus by placing an order at a reduced price based on quantity in order to save money.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al in view of MIT Report as applied to claims 3 and 4 above, and further in view of Rubin et al (6,078,897).

Green et al in view of MIT Report show all elements of the claim except a reduced price estimating means for estimating a reduced price. Rubin et al show a reduce price estimating means. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of Green et al by using the discount estimator of Rubin et al in order more easily facilitate the use of volume discounts.

Claim 5 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Epixtech.

Epixtech shows a reservation means and a means for registering the books into the stock information means. It is noted that it is inherently possible to register an unreceived book into the database since only data is needed to populate the database. Epixtech does not explicitly show reserving loan of the unreserved book. It is further noted that it is possible to reserve an item in the database.

Alternatively, Epixtech shows a reservation means and a means for registering the books into the stock information means. It is noted that it is inherently possible to register an unreceived book into the database since only data is needed to populate the database. Epixtech does not explicitly show reserving loan of the unreserved book. However, it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the apparatus to allow for reservation before receipt in order to facilitate the timely use of materials and to provide better user service.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over epixtech.

Epixtech shows all elements except SDI keyword registration means and new information sending means. However, it is notoriously old and well known in the art to register a SDI keyword and receive information when a new book corresponding to that keyword is registered. It would have been obvious to one of ordinary skill in the art to do so in order to provide the user with relevant information automatically, saving labor.

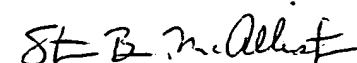
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister